

REMARKS**Summary of Phone Conference with Dr. Johan Richter on November 9, 2005**

Applicants wish to thank Supervisor Dr. Johan Richter for taking the time to speak with Applicants Representatives over the telephone regarding the current status of the claims on November 9, 2005. During the conversation, Dr. Richter noted that the most current claims were the claims from the verified English translation of the provisional Application No. 60/472,737 filed on September 20, 2004 (the image file wrapper erroneously identified this as a substitute specification), which superseded the claim in the Preliminary Amendment of May 21, 2004.

However, as set forth below, Applicants wish to clarify the record in that a substitute specification was never filed. It appears that the USPTO has improperly marked Applicants verified English Translation of Provisional Application No. 60/472,737 filed on September 20, 2004 as a substitute specification with replacement claims. Therefore, Applicants hereby request the USPTO to properly label the Verified English Translation of Provisional Application No. 60/472,737 filed September 20, 2005, instead of the current label which is "specification" and "claims," and "abstract."

Summary of Phone Conference with Examiner Zucker on November 16, 2005

Applicants also wish to thank Examiner Zucker for taking the time to speak with Applicants Representatives over the telephone regarding the status of the

present application on November 16, 2005. Examiner Zucker noted that he was returning a message left by Applicants representative on behalf of Dr. Richter.

During the conversation, Examiner Zucker noted that steps would be taken by the USPTO to correct the problem in the PTO's document system. Specifically, the Verified English Translation of Provisional Application No. 60/472,737 filed September 20, 2005 will be labeled as such, instead of the current label which is "specification" and "claims," and "abstract."

Summary of the Amendments

By the foregoing amendment, claims 1 and 2 will be cancelled, claims 3-5 will be amended, and claims 8-10 will be added, whereby claims 3-10 will be pending. Of the pending claims, claims 3, 4 and 8 are independent claims.

Support for the amendments to the claims can be found throughout Applicants' specification and, particularly, in Applicants' specification at pages 3-6.

Further, any amendments to the claims which have been made in this response and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Claim of Priority

Applicants thank the Examiner for acknowledging the claim of priority to U.S. Provisional Application No. 60/472,737, and also the claim of foreign priority based on Japanese Patent Application No. 2003-154372.

Information Disclosure Statement

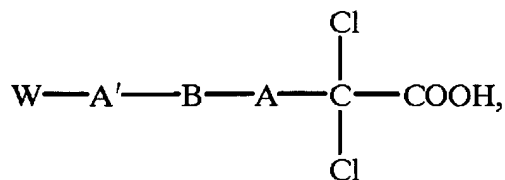
Applicants thank the Examiner for consideration of the Information Disclosure statement filed September 20, 2004.

Allowable Subject Matter

Applicants express with appreciation the indication that claim 3 is allowable. Claim 3 has been amended to, *inter alia*, correct a typographical error in the claim.

Rejection under 35 U.S.C. § 103(a)

Claims 1, 2 and 4-7 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Voss et al. (U.S. Pat. No. 5,968,982, hereinafter "VOSS"). In this ground of rejection, it is asserted, amongst other contentions, that VOSS teaches the following compound:



Wherein A is a C₅-C₂₀ alkyl, A' is a valency bond or alkylene chain of 1-10 carbon atoms, B is a carbonyl, and W is a phenyl group substituted with chlorine. (cols. 23-25, claims 1 and 5).

The Office Action further states that the compound of VOSS differs from the instantly claimed compound in that it is a subgenus of the compound of VOSS. The Office Action further indicates that one of ordinary skill in the art would have a reasonable expectation of success in practicing the instant invention by varying the substituents of the genus of VOSS to arrive at the instantly claimed compounds that are used for treating diabetes.

In response, Applicants have cancelled claims 1 and 2, and further amended each independent claim to the compounds selected from "2,2 dichloro-12-(4-chlorophenyl)-10-hydroxydodecanoic acid and 2,2 dichloro-12-(4-chlorophenyl)-11-hydroxydodecanoic acid, a salt thereof or an ester thereof." Therefore, because at least "2,2 dichloro-12-(4-chlorophenyl)-10-hydroxydodecanoic acid, their salts and esters" were noted in the Office Action as being allowable, claims 3-10 which further include a recitation of compounds selected from "2,2 dichloro-12-(4-chlorophenyl)-11-hydroxydodecanoic acid, a salt thereof or an ester thereof" should similarly be allowable because VOSS does not teach or suggest the currently recited compounds. Therefore, Applicants respectfully request that the 35 U.S.C. § 103(a) rejection of claims 1, 2 and 4-7 over VOSS be withdrawn.

Regarding newly added method claims 8-10, Applicants maintain that VOSS does not teach or suggest compounds selected from “2,2 dichloro-12-(4-chlorophenyl)-10-hydroxydodecanoic acid and 2,2 dichloro-12-(4-chlorophenyl)-11-hydroxydodecanoic acid, a salt thereof or an ester thereof.” Moreover, VOSS fails to teach any pharmacological method using the claimed compound. In contrast to the claimed invention, and as noted above, VOSS merely discloses a genus, with no suggestion or motivation to arrive at the instantly claimed compound or method. Therefore, in view of the differences between VOSS and the present claims, Applicants respectfully request that method claims 8-10 be allowed along with claims 3-6 because Applicants claimed method could not have been inherently practiced or suggested by VOSS.

Accordingly, for at least the reasons set forth above, claims 3-6 and newly-added method claims 8-10 should be indicated as allowable over VOSS, and the obviousness rejection should be withdrawn.

Rejection under 35 U.S.C. § 112

Claim 1 has been rejected under 35 U.S.C. § 112, first paragraph, because the phrase “a protective group” is not defined in the claim. Further, claims 5 and 7 have been rejected under 35 U.S.C. § 112, second paragraph, because while claims 5 and 7 are enabling for treating the claimed diseases, do not reasonably provide enablement for “preventing” the claimed diseases.

In response to the 35 U.S.C. § 112, first paragraph rejection of claim1, Applicants have cancelled claim 1 thereby making this rejection moot. Therefore, Applicants respectfully request that the 35 U.S.C. § 112, first paragraph rejection of claim 1 be withdrawn.

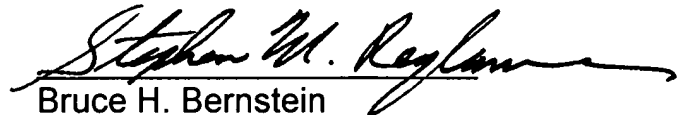
In response to the 35 U.S.C. § 112, second paragraph rejection of claims 5 and 7, Applicants have amended claim 5 to remove, *inter alia*, the word "preventive." Therefore, Applicants respectfully request that the 35 U.S.C. § 112, second paragraph rejection of claims 5 and 7 be withdrawn.

CONCLUSION

In view of the foregoing, it is submitted that none of the references of record, either taken alone or in any proper combination thereof, anticipates or renders obvious the Applicants' invention, as recited in each of claims 3-10. In addition, the applied references of record have been discussed and distinguished, while significant claimed features of the present invention have been pointed out.

Accordingly, reconsideration of the outstanding Office Action and allowance of the present application and all the claims therein are respectfully requested and now believed to be appropriate.

Respectfully submitted,
Keisuke INOUE et al.

A handwritten signature in black ink, appearing to read "Stephen M. Roylance", written over a horizontal line.

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